

REMARKS

Claims 1-19 are pending.

Claims 1, 3-5, 9, 10, 12 and 17 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick et al. '936 (*hereafter*: Fitzpatrick) in view of Davis '803. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 1 first calls for *a monitor having a screen and a front cover surrounding said screen*.

On page 5, in paragraph 10 of Paper No. 6, the Examiner refers us to Fitzpatrick's monitor 50 having a screen and a multi-point, touch sensitive surface 70 adjacent to the screen. and also refers us to col. 4, lines 3-10 of Fitzpatrick, which state: "Referring to FIG. 4, a graphical illustration of the interrelationship of components necessary to utilize the present invention is illustrated. A multi-point, touch-sensitive surface 70 which detects contact at given points is provided with the monitor 50 (see FIG. 3). An analog-digital converter 72 to pass data about contacts is positioned between the touch-sensitive surface 70 and a touch driver 74."

There is no mention of a *front cover surrounding* a screen by either Fitzpatrick or the Examiner, however, there is shown in Fig. 3 of Fitzpatrick a front cover (not numbered) similar to, but not the same as, Applicant's front cover 300 (see Fig. 4), wherein the front cover surrounds Fitzpatrick's screen (not numbered but implied to be Fitzpatrick's touch sensitive surface 70). See "touch screens" in col. 1, lines 10-13, "touch screen(s)" in col. 1, lines 59-68, and col. 2, lines 17-20 ("By touching a screen directly over a graphical object, a user may be granted access to the program

identified thereby only if there is a match with a file of authorized prints").

According to the above sections of Fitzpatrick, and since it is only disclosed in Fitzpatrick that it is touch sensitive surface 70 that is touched, and in particular, "which detects contact at given points," then touch sensitive surface 70 is the screen of monitor 50, contrary to the Examiner's attempt in paragraph 2 on page 2 of Paper No. 6 to indicate that Fitzpatrick's touch sensitive surface 70 is a "transparent touch-sensitive surface disposed *over* a display element as disclosed in Harkin (USPN 6,327,376. . .), which was not applied in the §103 rejection."

Fitzpatrick's display device is shown to be a cathode ray tube, which is in no way similar to Harkin's matrix liquid crystal display device. To suggest that Fitzpatrick's touch sensitive surface 70 is similar to Harkin's touch sensitive surface relies on supposition, not fact. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Claim 1, next calls for *a fingerprint recognizing module included with said monitor, said fingerprint recognizing module including a fingerprint image recognizing unit disposed on a surface of said front cover, wherein a user desiring access to said fingerprint recognizing display system touches said fingerprint image recognizing unit.*

In paragraph 10, the Examiner refers us to Fitzpatrick's fingerprint analyzer 82 as the *fingerprint recognizing module*, and also refers us to col. 4, lines 14-21 which state: "In a second path, the touch driver 74 communicates with a fingerprint analyzer 82. A fingerprint image is

communicated to the analyzer 82 in a form appropriate to distinguish a unique fingerprint, as is known in the art. Once an operator touches a field or an icon, a fingerprint template is compared to an associated "per-icon" access table found in the access grantor 76."

In paragraph 11, the Examiner notes that Fitzpatrick fails to disclose that the fingerprint recognizing module including a fingerprint image recognizing unit is *disposed on a surface of said front cover* surrounding the screen of the monitor, and applies Davis in this regard.

In particular, the Examiner refers us to Davis' col. 3, lines 46-58 which state, in part: "biometric device 120 (e.g., a biometric scanner of facial or hand geometries, iris patterns, voice synthesizer) is preferably positioned separate from the display monitor 111 as shown and interconnected to the PC 110 through a communication line 130. It is contemplated, however, that the biometric device 120 may be implemented internally within the casing of the display monitor 111, the casing of the PC 110, positioned on the input device 112 and the like. "

The Examiner then holds that it would have been obvious, in view of Davis, to place the fingerprint unit anywhere on the monitor, and then states "It would have been obvious to one of ordinary skill in the art . . .to internally implement a biometric device (fingerprint unit) within the casing of a display monitor as taught by Davis in order to localize the processing . . .".

It is not clear how the user could touch a fingerprint unit if it was mounted "within the casing of a display monitor" as suggested by the Examiner. One of ordinary skill in the art would have positioned a fingerprint unit on the input unit (keyboard or mouse) 112 of Davis, instead, because input unit 112 is usually easier to reach than the display monitor 111.

The Examiner fails to positively suggest one of ordinary skill in the art would have been

motivated by Davis to modify Fitzpatrick in anyway, and thus fails to provide a *prima facie* basis of obviousness.

The Examiner fails to suggest one of ordinary skill in the art would have been motivated by Davis to modify Fitzpatrick to provide a *fingerprint recognizing module including a fingerprint image recognizing unit disposed on a surface of said front cover*, as set forth in the claim. Instead, it appears that the Examiner suggests putting Fitzpatrick's fingerprint unit (?) in the within the casing of the monitor 50.

The Applicant has no problem with holding that Fitzpatrick's fingerprint analyzer 82 may be within the casing of monitor 50, however, that is not what is claimed, and that is not the feature noted as lacking in both Fitzpatrick and Davis. It is the feature that the *fingerprint recognizing module including a fingerprint image recognizing unit disposed on a surface of said front cover* that the Examiner notes that "neither Fitzpatrick nor Davis explicitly disclose."

Note also that the second feature of claim 1 includes the limitation *a user desiring access to said fingerprint recognizing display system touches said fingerprint image recognizing unit*. Accordingly, a user touches a fingerprint image recognizing unit disposed on a surface of a front cover surrounding a screen of a monitor.

In Fitzpatrick, a user touches the screen, i.e., touch-sensitive surface 70. It is clearly Fitzpatrick's "desire to create a more user-friendly system" by using "touch screen technology" which "enables direct object selection by a user's fingers contacting a touch screen surface directly over a graphical object."

Additionally, Fitzpatrick desires to control access to the stored information as described in

col. 3, lines 52-68, which state: "In order to gain access to any of the data or programs indicated by one of the touch screen fields 54, 56, 58, 60, 62, 64, 66 or 68 an operator must place their fingertip thereon. At that point, a fingerprint recognition device interconnected to the monitor 50 will check for authorized access. If the operator is authorized access to that data/program, the data/program will be presented to the operator. Any single operator may be authorized access to one or more of the programs/files presented on the monitor 50. Similarly, all operators in a department/group may access data/programs through the monitor 50 only if they are authorized for the specific information they are attempting to gain access to. By using the present invention, the unattended monitor 50 has a reduced likelihood of being used to compromise data by personnel not authorized access thereto."

There has been no showing that Fitzpatrick's system would still be as "user-friendly" as desired, and also maintain the access control desired by Fitzpatrick if Fitzpatrick were modified to dispose a fingerprint image recognizing unit on a surface of the front cover surrounding the screen of monitor 50, instead of using a touch screen having touch-sensitive surface 70. Any modification that would destroy the intended purpose of Fitzpatrick's device such that it would no longer be able to function as intended is an important indication of non-obviousness, see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Note that Fitzpatrick's device is very "user-friendly," because a user having authorized access to data corresponding to touch screen fields 54, 56, 58, 60, 62, 64, 66 and 68 need only provide a single touch to the touch screen field desired, instead of having to provide an number of different inputs via a mouse or keyboard to locate and select the data desired. Additionally, a second user having only access to data corresponding to touch screen fields 54, 56, 58, 60, 62, 64 and 66 cannot

access the data corresponding to touch screen field 68 is quickly denied access to the data corresponding to touch screen field 68 when the second user touches touch screen field once, instead of having to go through a number of inputs just to be denied access to that data.

Thus there has been no showing that Fitzpatrick's system would still function as intended and maintain the desired "user-friendliness."

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn, because one of ordinary skill in the art would not have motivated by Davis to modify Fitzpatrick, and since such a modification would destroy the intent of Fitzpatrick's device of being user-friendly and maintain ability to provide different levels of access to various data stored in the system while maintaining such user-friendly capability.

Thus the feature of a fingerprint recognizing means located on a front or side panel of the front cover surrounding a display screen, set forth in each of the rejected claims would not have been obvious under §103. Therefore, the rejection of claims 3-5, 9, 10, 12 and 17 is also deemed to be in error and should be withdrawn.

Claim 4 also calls for *a microprocessor communicating with a video card in said computer main body*. Fitzpatrick fails to disclose either of the microprocessor communicating and the video card. Here, the Examiner, erroneously applying inherency, refers us to Fitzpatrick's touch driver 74 and graphical user interface 78 as the microprocessor and the video card, respectively.

In re Rijckaert, 28 USPQ 1953, 1957 (CAFC 1993) "a retrospective view of inherency is not

a substitute for some teaching or suggestion supporting an obviousness rejection", citing *In re Newell*, 891 F.2d 899,901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Accordingly, the rejection of claim 4 is deemed to be in error and should be withdrawn.

Claim 11 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick in view of Davis and in further view of Srey et al '436 (hereafter: Srey). Claim 2 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick in view of Davis as applied to claim 1, and in further view of Srey. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 11 calls for a front cover surrounding a display screen, a power switch placed on a predetermined portion of said front cover, and fingerprint recognizing means formed integrally with the power switch to read a fingerprint image of a user. See also claim 2.

The combined teachings of Fitzpatrick and Davis have been discussed above with respect to the rejection of claims 1, 3-5, 9, 10, 12 and 17, wherein it was shown that one of ordinary skill in the art would not have been motivated to modify Fitzpatrick, since such a modification would destroy the intended purpose of Fitzpatrick's device such that it would no longer be able to function as intended, such destruction is an important indication of non-obviousness. *In re Gordon*, supra.

Srey was cited for teaching fingerprint recognizing means formed integrally with a power switch. That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*,

supra.

Srey does not provide any teaching which would suggest that the modification of Fitzpatrick would enable Fitzpatrick to continue to function as desired, since providing a fingerprint recognizing means formed integrally with the power switch instead of using the screen's touch sensitive surface 70 would destroy the intent of Fitzpatrick's device of being user-friendly and maintain ability to provide different levels of access to various data stored in the system while maintaining such user-friendly capability.

Accordingly, the rejections of claims 11 and 2 are deemed to be in error and should be withdrawn.

Claims 6-8, 13-16, 18 and 19 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick in view of Davis as applied to claims 1, 3 and 5 and in further view of O'Connor et al. '306 (*hereafter*: O'Connor). The Applicant respectfully traverses this rejection for the following reason(s).

O'Connor does not provide any teaching which would suggest that the modification of Fitzpatrick would enable Fitzpatrick to continue to function as desired, since providing a fingerprint recognizing means formed integrally with the power switch instead of using the screen's touch sensitive surface 70 would destroy the intent of Fitzpatrick's device of being user-friendly and maintain ability to provide different levels of access to various data stored in the system while maintaining such user-friendly capability.

Accordingly, the rejection of claims 6-8, 13-16, 18 and 19 is deemed to be in error and should be withdrawn.

Note also, that claims 6-8 call for *an encoding unit for encoding fingerprint data for storage into said fingerprint data base.*

It appears that the Examiner is relying on O'Connor's encode/compress circuitry 207, however, the encoded signal output from encode/compress circuitry 207 is only applied to decode/decompress circuitry 211, and there is no teaching that the encoded signal output from encode/compress circuitry 207 is stored in memory device 223.

Additionally, there is no teaching in the relied upon art of O'Connor for *a decoding unit for decoding the registered fingerprint data read from said fingerprint data base.*

The Examiner suggests that it would have been an obvious variant to utilize the encode/compress and decode/decompress functions for storage and retrieval of fingerprint data in order to improve efficiency and security. There has been no shown proof that efficiency and security would be improved by utilizing the encode/compress and decode/decompress functions for storage and retrieval of fingerprint data. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Further, the Examiner's discussion of inherency regarding an apparent temporary storage of fingerprint data is not understood, since there is no claim of temporary storage. Also, a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness

rejection. *In re Rijckaert*, supra.

Further, claims 6-8, for example, call for *a fingerprint matching/recording unit . . . for outputting said distinctive feature received from said distinctive feature detecting unit to said encoding unit to be stored as the registered fingerprint data in said fingerprint data base.*

The Examiner correctly notes that Fitzpatrick fails to disclose this feature and relies on O'Connor's analysis circuit 213 and compare circuit 221.

Clearly, O'Connor fails to teach or disclose the foregoing feature of claims 6-8. Neither compare circuit 211 nor analysis circuit 213 of O'Connor receive decoded fingerprint data from a decoding unit, wherein the decoding unit decodes registered fingerprint data read from a fingerprint data base, neither provide fingerprint data to an encoding unit.

Accordingly, the rejection is deemed to be in error and should be withdrawn.

Claim 14 calls for *performing a fingerprint registration routine when it is determined that said fingerprint data base has not been established.* Neither reference discloses or teaches the foregoing step as neither reference is drawn to creating a fingerprint data base, but instead they are drawn to fingerprint recognition based on an already established fingerprint database.

The Examiner states that this feature is "inherent" in order to validate a user's identity. A retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *In re Rijckaert*, supra.

The Examiner indicates that it would have been obvious perform *a fingerprint registration routine* to establish a database of at least one valid signature (fingerprint) so as to prevent

unauthorized users from assessing sensitive information. The Examiner has not shown, however, that it would have been obvious to perform such a step of *performing a fingerprint registration routine after* making a determination that a fingerprint data base has not been established, as required by the claim. O'Connor clearly teaches that if there are no fingerprints in the database, all user get a pass, thus there is no security concern. If there is no security concern, there is no need to register a fingerprint in a database (memory 213). That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, supra.

Claim 18 calls for, in part, *determining whether a file stored in said computer system is enabled to be encoded or decoded during operation of a file encoding/decoding routine of said computer system.*

The Examiner states "Fitzpatrick does not disclose determining whether a file stored in said computer system is enabled to be encoded or decoded." Then the Examiner states "It would have been obvious to one of ordinary skill in the art . . . to determine whether a file stored in said computer system is enabled to be encoded or decoded . . . as taught by Fitzpatrick."

The two statements by the Examiner are contrary to each other. It appears from the Examiner's discussion of Fitzpatrick's teach of determining whether a user has authorized access to certain files, that the Examiner is trying to equate authorized access to enabling a file to be encoded or decoded. There is no equivalency in this regard, contrary to the Examiner's discussion of the art, especially since a user is clearly not equivalent to a stored file.

Accordingly, the rejection of claim 18 is deemed to be in error and should be withdrawn.

Claim 19 calls for, in part, *permitting said manager to operate a fingerprint managing and registering program when said comparing step indicates that there is a match between the fingerprint data transmitted from said monitor and the registered fingerprint data output from said fingerprint data base*

Neither reference provides a teaching of a *fingerprint managing and registering program*, and neither reference teaches permitting a *manager to operate a fingerprint managing and registering program*. The Examiner attempts to equate an operator of Fitzpatrick's system to the claimed *manager*. That would mean that anyone operating Fitzpatrick's system would be a manager and would have the ability to do whatever they desired to the system. Accordingly, security would clearly be compromised if anyone (operator) accessing Fitzpatrick's system were a manager.

Accordingly, the rejection of claim 19 is deemed to be in error and should be withdrawn.

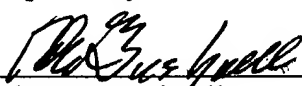
Accordingly, the rejection of claims 6-8, 13-16, 18 and 19 is deemed to be in error and should be withdrawn for the foregoing reasons..

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the

Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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